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09/809,150	03/14/2001	Salil Vjaykumar Pradhan	10005619-1	5410

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EXAMINER
KUCAB, JAMIE R

ART UNIT	PAPER NUMBER
3621	

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11/28/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	09/809,150	PRADHAN ET AL.
	Examiner	Art Unit	
	JAMIE KUCAB	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>01 May 2008</u>.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-9,21,23 and 28-30</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-9, 21, 23, and 28-30</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail. Date _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Acknowledgements

1.   Applicant's response filed May 1, 2008 is acknowledged.

2.   Claims 1-9, 21, 23, and 28-30 are pending in the application.

3.   This Office action is given Paper No. 20081120 for reference purposes only.

4.   The Examiner for this application has changed. Please note that the Examiner of record is now Jamie Kucab.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6.   Claims 1-9, 21, 23, and 28-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In claim 22, the limitation of "a virtual identifier of the merchant web site is determined by passively interrogating a source, the source being operable to transmit or broadcast the virtual identifier to a client device in a predetermined range" is not described in the specification. There is no explanation or description in the specification of how the source is passively interrogated. There is mention of some type

of beacon but the beacon is not described at all in the specification. The specification

fails to describe how the source receives the virtual identifier. Furthermore, there is no

description or explanation of how the virtual identifier is broadcast to the source. As far

as the Examiner can ascertain, the only mention in the specification that a virtual

identifier of the merchant web site is determined by passively interrogating a source, the

source being operable to transmit or broadcast the virtual identifier to a client device in a

predetermined range is the statement mirroring this language on page 15, lines 1-5.

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

8.   Claims 1-6, 21-23 and 28-30 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Websphere product as evidenced by McCord, Mark, "IBM rolls out

suite for easy Internet access" (hereinafter Websphere1) and Beck, Bob et al., "IBM

Websphere Everyplace Suite v 1.1 White Paper" (hereinafter Websphere2) in view of

Gregory, Pat. No. 6,490,567 and Stolfo et al., Pub. No. 2001/0044785 (hereinafter

Stolfo) and further in view of Examiner's Official Notice.

      The Examiner notes that the McCord and Beck et al. articles describe the same

product called Websphere. The Websphere product is the basis of the rejection of the

claims.

As to claim 1, Websphere discloses A method for providing mediated services to
a client device having a predetermined communication protocol and a predetermined
display format (i.e. a new range of middleware that can decode Web content and re-
format to fit on any wireless instrument and WAP enabled phone)(Websphere1, page 1,
paragraph 5) comprising:

(a) receiving a request for a web page from the client device (i.e. necessary web
site is pulled up on a mobile phone …)(Websphere1, page 2, paragraph 1);

(b) sending the request to a merchant web site (i.e. link all sites to any
devices)(Websphere1, page 2, paragraphs 1, 3, and 6) and ;

(c) receiving the requested information from the merchant web site at a mediator;

(d) transforming the information into the predetermined communication protocol
and predetermined display format that is suitable for the client device at the
mediator (i.e. a new range of middleware that can decode Web content and re-
format to fit on any wireless instrument and WAP enabled phone)(Websphere1,
page 1, paragraph 5) and (i.e. protocol translation as a WAP gateway, support
for short messaging … changing HTML content intended for desktop PC's to
WML content suitable for the new class of smart phones)(Websphere2, page 7,
page 8); and

(e) sending the information via a network to the client device from the mediator
(i.e. a new range of middleware that can decode Web content and re-format to fit
on any wireless instrument and WAP enabled phone)(Websphere1, page 1,

paragraph 5) and (i.e. protocol translation as a WAP gateway, support for short

messaging … changing HTML content intended for desktop PC's to WML

content suitable for the new class of smart phones)(Websphere2, page 7, page

8) and

 (paragraph 44);

Websphere does not explicitly disclose

(f) providing mediated shipping services, wherein the step of providing mediated

shipping services includes the client sending delivery information to the mediator

the mediator directly providing the delivery information to a shipping company

However, Gregory teaches providing mediated shipping services, wherein the step of

providing mediated shipping services includes the client sending delivery information to

the mediator (i.e. customer profile and shipping address)(col. 4, lines 47-50 and col. 9,

lines 22-26).). It would have been obvious to one of ordinary skill a the time of

Applicant's invention to include the aforementioned limitation within Websphere as

taught by Gregory for the motivation of providing a more efficient way of conducting

electronic commerce by allocating most of the tasks of providing electronic commerce

transaction functionality to a service provider thereby relieving the merchant from tasks

outside their area of expertise (col. 2, lines 17-28).

Websphere and Gregory do not explicitly disclose

directly providing the delivery information to a shipping company

arranging for the shipping company to pick-up the merchandise from the

merchant; wherein the client delivery information is not provided to the merchant.

However, Stolfo teaches directly providing the delivery information to a shipping

company (paragraph 32). Stolfo further teaches arranging for the shipping company to

pick-up the merchandise from the merchant; wherein the client delivery information is

not provided to the merchant (i.e. customer's proxy information (paragraphs 32 and 33).

It would have been obvious to one of ordinary skill at the time of Applicant's invention to

include the aforementioned limitation within Websphere and Gregory as taught by Stolfo

for the motivation of securely ordering and receiving products from merchants without

revealing their identities to the merchants (paragraph 2).

The combination of Websphere/Gregory/Stolfo does not explicitly disclose wherein a

virtual identifier of the merchant web site is determined by passively interrogating a

source, the source being operable to transmit or broadcast the virtual identifier to a

client device in a predetermined range.

However, the Examiner takes official notice that broadcasting virtual identifiers was old

and well known in the electronic advertising arts. The motivation for broadcasting virtual

identifiers was to seek potential customers for goods or services. It would have been

obvious to one of ordinary skill in the art at the time of Applicant's invention to include

the aforementioned limitation within Websphere for the motivation stated above.

As to claim 2, Websphere discloses The method of claim 1 further comprising:

(f) providing at least one mediated electronic commerce service for a merchant (i.e. a

new range of middleware that can decode Web content and re-format to fit on any

wireless instrument and WAP enabled phone)(Websphere1, page 1, paragraph 5).

As to claim 3, Websphere does not explicitly disclose The method of claim 2 wherein

the step of providing at least one electronic commerce service for the merchant includes

one of shopping cart services, billing services, shipping services, and payment services.

However, Gregory discloses the step of providing at least one electronic commerce

service for the merchant includes one of shopping cart services, billing services,

shipping services, and payment service (col. 4, lines 40-47). It would have been obvious

to one of ordinary skill a the time of Applicant's invention to include the aforementioned

limitation within Websphere as disclosed by Gregory for the motivation of providing a

more efficient way of conducting electronic commerce by allocating most of the tasks of

providing electronic commerce transaction functionality to a service provider thereby

relieving the merchant from tasks outside their area of expertise (col. 2, lines 17-28).

As to claim 4, Websphere discloses The method of claim 1 wherein the step of

transforming the information into the predetermined communication protocol and

predetermined display format that is suitable for the client device includes:

transforming the information into one of an HTTP communication protocol and WAP

communication protocol (Websphere2, pages 7-8).

As to claim 5, Websphere discloses The method of claim 1 wherein the step of

transforming the information into the predetermined communication protocol and

predetermined display format that is suitable for the client device includes:

transforming the information into one of a HTML display format and VML display format

(Websphere2, page 8).

As to claim 6, Websphere discloses The method of claim 1 wherein the step of receiving

the requested information from the merchant web site includes:

receiving information in one of a proprietary format, a mark-up language format, an XML

format, and other format designed for exchanging information (Websphere2, pages 7-

8).

As to claim 21, Websphere discloses The method of claim 1, wherein the step of

receiving a request for a web page comprises receiving a request for a web page from

the client device, wherein the request includes a request for product information from

the merchant web site (Websphere1, page 2, paragraphs 1-4).

As to claim 23, Websphere discloses The method of claim 1, wherein a virtual identifier

of the merchant web site is determined by scanning readable code (i.e. URL of the web

site)(Websphere1, page 2, paragraphs 1-4).

As to claim 28, Websphere discloses The method of claim 1, wherein transforming the

information into the predetermined communication protocol and predetermined display

format that is suitable for the client device at the mediator further comprises

transforming the information into a plurality of different predetermined communication

protocols and a plurality of different predetermined display formats for a plurality of

clients based on a display format and a communication protocol used by each of a

plurality of client devices (Websphere2, pages 7-8).

As to claim 29, Websphere discloses The method of claim 28, wherein sending the

transformed information via a network to the client device from the mediator further

comprises sending the transformed information to the plurality of clients using the

plurality of different predetermined communication protocols and the plurality of different

predetermined display formats (Websphere2, pages 7-8).

As to claim 30, Websphere discloses The method of claim 1, wherein receiving the requested information from the merchant web site at a mediator further comprises receiving the requested information in a generic display format from the merchant web site (Websphere2, pages 7-8).

9.   Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Websphere, Gregory and Stolfo as applied to claim 1 above, and further in view of Godden et al., Pat No. 6,401,077 (hereinafter Godden).

As to claim 7, Websphere, Gregory and Stolfo do not explicitly disclose The method of claim 1 further comprising:

(f) providing mediated shopping services wherein the step of providing mediated shopping services includes the client device sending a request to add or delete items from a shopping cart ; and receiving the add or delete requests, and responsive thereto for updating a shopping cart record.

However, Godden teaches providing mediated shopping services wherein the step of providing mediated shopping services includes the client device sending a request to add or delete items from a shopping cart ; and receiving the add or delete requests, and responsive thereto for updating a shopping cart record (col. 6, lines 16-22). It would have been obvious to one of ordinary skill a the time of Applicant's invention to include the aforementioned limitation as taught by Godden within Websphere, Gregory and Stolfo for the motivation of providing a mechanism for web sites that are not e-commerce enabled to be enabled to conduct commerce (col. 2, lines 42-46).

As to claim 8, Websphere, Gregory and Stolfo do not explicitly disclose The method of claim 1 further comprising:

(f) providing mediated payment services wherein the step of providing mediated payment services includes the client sending a purchase request to purchase one or more items in a shopping cart; receiving the purchase request; and responsive to the purchase request for updating a shopping cart record to reflect the purchase.

However, Godden teaches providing mediated payment services wherein the step of providing mediated payment services includes the client sending a purchase request to purchase one or more items in a shopping cart(i.e. added purchase buttons)(col. 9, lines 13-20); receiving the purchase request(col. 9, lines 13-20); and responsive to the purchase request for updating a shopping cart record to reflect the purchase (i.e. add that item to the shopping cart)(col. 9, lines 13-20). It would have been obvious to one of ordinary skill at the time of Applicant's invention to include the aforementioned limitation as taught by Godden within Websphere, Gregory and Stolfo for the motivation of providing a mechanism for web sites that are not e-commerce enabled to be enabled to conduct commerce (col. 2, lines 42-46).

As to claim 9, Websphere does not explicitly disclose The method of claim 8 wherein the step of providing mediated payment services further includes a client providing payment information to a mediator; the mediator debiting a client's account; and the mediator handling payment to a merchant; wherein the account information of the client is not provided to the merchant.

However, Gregory teaches the mediator debiting a client's account ; and the mediator

handling payment to a merchant; wherein the account information of the client is not

provided to the merchant (col. 4, lines 40-47). It would have been obvious to one of

ordinary skill a the time of Applicant's invention to include the aforementioned limitation

within Websphere as taught by Gregory for the motivation of providing a more efficient

way of conducting electronic commerce by allocating most of the tasks of providing

electronic commerce transaction functionality to a service provider thereby relieving the

merchant from tasks outside their area of expertise (col. 2, lines 17-28).

Response to Arguments

10.   With regard to Applicant's traversal of the Official Notice of claim 1, the Applicant

failed to timely and properly traverse the Official Notice as applied to claim 22 in the

Office action mailed 4/6/07, therefore, as stated in the previous Office action mailed

9/24/07, the Official Notice (now applied to claim 1 due to Applicant's amendment) is

maintained as common knowledge.

11.   With regard to Applicant's argument that the description of the limitation "a virtual

identifier of the merchant web site is determined by passively interrogating a source, the

source being operable to transmit or broadcast the virtual identifier to a client device in a

predetermined range" is adequate for one of ordinary skill in the art to make and use the

invention with this limitation, the Examiner must respectfully disagree. As Applicant

makes only an assertion that the disclosure is enabling, the Examiner does not have

any arguments to address. The Examiner would like to add that the claimed method by

which a virtual identifier is determined (by "passively interrogating" a source) is not described in the specification at all. At page 14 line 26 - page 15 line 11, Applicant describes two methods of determining a virtual identifier: "There are two primary ways to access virtual identifiers (URLs) of products or services of interest. The first way is through **passive reception**. ... The second way is through **active interrogation**" [emphasis added]. Applicant lists only two methods of communicating virtual identifiers: (1) "passive reception" and (2) "active interrogation." Applicant does not list any other methods of communicating the virtual identifier, yet in claim 1, Applicant is attempting to claim "passively interrogating" as the method of communicating the virtual identifier. This is not one of the two methods of communicating a virtual identifier listed by Applicant in the specification; therefore, it is not enabled by the specification. As passive interrogation is a complex task, one of ordinary skill in the art would not be enabled to use the invention simply by reading the limitation as recited.

Findings of Fact

12.   It is the Examiner's factual determination that there are at least three (3) basic types of RF tags: passive RF tags, active tags without a battery, and active tags with a battery. See e.g. Ghaem (5,495,250) C1 L45 - C2 L24 for a discussion of the strengths and weaknesses of these three types of tags.

Conclusion

13.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

14.   A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

15.   References considered pertinent to Applicant's disclosure are listed on form

PTO-892. All references listed on form PTO-892 are cited in their entirety.

16.   Any inquiry concerning this communication or earlier communications from the

Examiner should be directed to Jamie Kucab whose telephone number is 571-270-

3025. The Examiner can normally be reached on Monday-Friday 9:30am-6:00pm EST.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's

supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

17.   Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JK

/Calvin L Hewitt II/

Supervisory Patent Examiner, Art Unit 3685